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10/091,209	03/04/2002	Richard L. Palinkas	0069-UP	6369

7590

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 08/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/091,209

Applicant(s)

PALINKAS ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 13-19 is/are allowed.
- 6) ☒ Claim(s) 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Specification*

1. The specification is objected to for the following informalities: the use of the trademarks ADRIPRENE® and VIBRATHANE® have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. See, for example, particularly page 10, lines 22 and 23. Applicant is advised that any other trademarks used in this specification should conform to this practice.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 7-9, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Reuter et al. (U.S. Patent No. 2,951,053).

It is noted for claim 7, that the preamble states the purpose of the claimed invention. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or

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intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"); *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim).

For claim 7, in column 1, lines 43-54, Reuter describes an elastomeric polyurethane composition. In column 2, lines 24-29, Reuter describes the addition of a dimethylsiloxane polymer that is present in liquid form. In column 2, lines 19-23, Reuter teaches that the silicone polymer is added in an amount of 0.01 to 5% by weight, which significantly overlaps the range set forth in claim 7. In column 2, line 70 through column 3, line 22, Reuter describes the addition of a curative. For claims 11 and 12, Reuter lists 1,4-butylene glycol (1,4-butanediol) as a suitable curative. In column 3, line 68 through column 4, line 12, Reuter discloses that the components are mixed and cured. Here, for claim 9, Reuter teaches polyester polyols having a molecular weight of 2000, which is above the minimum weight set by applicant in the claims. For claim 8, in column 2, lines 59-69, Reuter teaches suitable diisocyanates including toluene-2,4-diisocyanate, set forth by applicant in the claim.

4. Claims 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kausch et al. (U.S. Patent No. 5,674,567).

It is noted for claim 7, that the preamble states the purpose of the claimed invention. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"); *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim).

For claim 7, in column 1, lines 23-41, Kausch describes a polyurethane composition containing a silicone oil. In column 2, lines 24-29, Kausch describes the addition of a dimethylsiloxane polymer that is present in liquid form. In column 2, lines 19-23, Kausch teaches that the silicone polymer is preferably added in an amount of 2 to 20 parts by weight, which significantly overlaps the range set forth in claim 7. In column 4, line 49 through column 5, line 33, Kausch describes the addition of a curative. For claims 11 and 12, in column 5, lines 18-19, Kausch lists ring methylated phenylene

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diamines as suitable curatives. For claims 9 and 10, in column 1, line 51 through column 2, line 4, Kausch teaches polyether polyols having a molecular weight of at least 400, which is above the minimum weight set by applicant in the claims. Here, Kausch includes polyoxyethylene as the polyether, which falls within applicant's formula where R is ethylene. For claim 8, in column 2, line 62 through column 3, line 27, Kausch teaches suitable diisocyanates including toluene-2,4-diisocyanate, set forth by applicant in the claim.

5. Claims 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by General Tire and Rubber Co. (General Tire) (G.B. Patent Specification No. 908,012):

It is noted for claim 7, that the preamble states the purpose of the claimed invention. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"); *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim).

For claim 7, on page 1, line 62 through page 2, line 3, General Tire describes a polyurethane composition containing a silicone oil. On page 2, lines 44-80, General Tire describes the addition of a dimethylsiloxane polymer that is present in liquid form. On page 2, line 102 through page 3, line 5, General Tire teaches that the silicone polymer is preferably added in an amount of 0.1 to 5 % by weight, which overlaps the range set forth in claim 7. In column 4, line 49 through column 5, line 33, General Tire describes the addition of a curative. For claims 11 and 12, on page 4, lines 34-49, General Tire lists trimethylol propane as a suitable curative. For claims 9 and 10, on page 3, lines 106-124, General Tire teaches polyether polyols having a molecular weight of at least 750, which is above the minimum weight set by applicant in the claims. Here, General Tire also teaches polyether polyols of applicant's formula. For claim 8, on page 3, lines 42-50, General Tire teaches suitable diisocyanates including paraphenylene diisocyanate, set forth by applicant in the claim.

### ***Response to Arguments***

6. Applicant's arguments filed 6/18/03 have been fully considered but they are not persuasive with respect to claims 7-12. For claims 7-12, applicant has inserted the phrase "having improved abrasion resistance with no significant loss in friction" into the preamble of claim 7. As detailed above, the preamble has been give no patentable weight, and therefore the rejections of claims 7-12 have been continued. The rejections of claims 1-6 have been withdrawn in light of applicant's amendments and comments.

***Allowable Subject Matter***

7. Claims 1-6 and 13-19 are allowed.

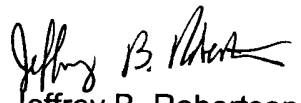
***Conclusion***

8. This rejection is not made final because of the new objection to the specification regarding the use of trademarks as set forth in paragraph 1 above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Jeffrey B. Robertson  
Primary Examiner  
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JBR